

Serial No. 10/762,559
Docket No. K06-165935M/TBS

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REMARKS

Applicants' concurrently file herewith a Petition for Extension of Time, and corresponding extension of time fee, for a one-month extension of time.

Claims 1-19 are all the claims presently pending in the application. Claims 20 and 21 have been canceled without prejudice or disclaimer. Claims 1, 5, and 9 have been amended to more particularly define the claimed invention.

Entry of this Amendment is believed proper since no new issues are being presented to the Examiner that would require further consideration and/or search.

Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claim 21 stands rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Claims 1-8, 15, 20 and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Iguchi et al. (U.S. Patent No. 6,270,596; hereinafter "Iguchi"). Claims 1-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Iguchi.

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention of exemplary claim 1 provides a steel for use in a high strength pinion shaft wherein the steel is devoid of Cr, Cu, Ni and Al (e.g., see Application at page 7, lines 13-24 and Table 1). These features are important for providing a steel for use in a high strength pinion shaft which is not refined and used by high frequency hardening, with less occurrence of peeling upon hobbing, having higher surface hardness and impact value and torsional strength after high frequency hardening, and with less heat treatment strains (see

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Application at page 5, lines 5-12).

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II. THE WRITTEN DESCRIPTION REQUIREMENT

The Examiner alleges that claim 21 allegedly fails to comply with the written description requirement.

Applicants submit that claim 21 has been canceled, thus rendering this rejection moot.

III. PRIOR ART REFERENCE

The Examiner alleges that Iguchi teaches the claimed invention of claims 1-8, 15, 20 and 21. Furthermore, the Examiner alleges that the claimed invention of claims 1-21 would have been obvious in view of Iguchi. Applicants submit, however, that Iguchi does not teach or suggest (nor make obvious) each and every feature of the claimed invention.

That is, Iguchi does not teach or suggest a steel for use in a high strength pinion shaft “*wherein the steel is devoid of Cr, Cu, Ni and Al*”, as recited in claim 1 and similarly recited in claims 5 and 9.

The Examiner attempts to rely on Steel 7 in Table 1 and the Abstract of Iguchi to support his allegation. The Examiner, however, is clearly incorrect.

That is, nowhere in this table nor the Abstract (nor anywhere else for that matter) does Iguchi teach or suggest a steel for use in a high strength pinion shaft wherein the steel is devoid of Cr, Cu, Ni and Al.

Indeed, all of the examples in Table 1 of Iguchi include Cr, Cu, Ni and Al. Thus, Iguchi clearly does not teach or suggest that the steel is devoid of Cr, Cu, Ni and Al, as recited in the claimed invention.

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Therefore, Applicants submit that Iguchi does not teach or suggest each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicants submit that claims 1-19, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

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